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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,183	06/08/1999	OVERTON L. PARISH IV	27889-00037	6471

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EXAMINER

ATKINSON, CHRISTOPHER MARK

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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29

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/24/02

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 5, 7, 12-20 + 38 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6, 8-11 + 21-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Response to RCE and Amendment

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claims 5, 7, 12-20 and 38 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11. Claims 5, 7 and 12-13 do not read on the elected species but rather on non-elected species B.

Specification

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the originally filed specification fails to disclose the elected embodiment of Figure 1 having the claimed first and second seals.

Claim Rejections - 35 USC § 112

Claims 1-4, 6, 21-22, 25-26, 29-32, 34 and 36-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 21, the originally filed specification fails to disclose the elected embodiment of Figure 1 having the claimed first and second seals.

Claims 1-4, 6, 8-11 and 21-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the plurality of claim indefinite problems within the claims, the Examiner has only listed a few of the problems and it is requested applicant correct all claim errors. Regarding claim 1, the recitation “the at least one heat generating component” is indefinite and creates an inconsistency in the claim since the preamble indicates a subcombination

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since there is no positive recitation of “the at least one heat generating component” while the body of the claim indicates a combination since “the at least one heat generating component” has been positively recited. Therefore, the Examiner cannot be sure if applicant’s intent is to claim the subcombination or the combination. Regarding at least claim 5, the recitation “said first exterior extrusion surface lacks antecedence.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1-3, 6, 8-11 and 21-37 are rejected under 35 U.S.C. § 103 as being unpatentable

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over Wrigth et al. in view of al Fox et al.

The patent of Wrigth et al. discloses all the claimed features of the invention with the exception of fins, a circuit board, a means for circulating the heat transfer fluid and a means for removing heat from the heat transfer fluid. The height of the device and the claimed channel cross-section are considered to be an obvious design choices dependent upon spacial and flow requirements which do not solve any stated problem or produce any new and/or unexpected result.

The patent of Fox et al. in Figures 1-6 discloses that it is well known in the heat transfer art to have fins on a heat exchanger, a circuit board, a means for circulating the heat transfer fluid and a means for removing heat from the heat transfer fluid for the purpose of cooling a heat generating device with a closed loop heat transfer system. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in as disclosed in Wrigth et al. fins, a circuit board, a means for circulating the heat transfer fluid and a means for removing heat from the heat transfer fluid for the purpose of cooling a heat generating device with a closed loop heat transfer system. Fox et al.

Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Wrigth et al. in view of Fox et al. as applied to claims 1-3, 6, 8-11 and 21 above, and further in view of applicant's omission of known/convention prior art.

The patent of Wrigth et al. as modified, discloses all the claimed features of the invention with the exception of a plated metal.

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Applicant's omission of known/convention prior art in his specification on page 7 discloses that it is known to have a second material between the heat exchanger and the component for the purpose of reducing thermal resistances and attaching the component to the heat exchanger. The material being metal is considered to be an obvious design expedient. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Wrigth et al. as modified, a second material between the heat exchanger and the component for the purpose of reducing thermal resistances and attaching the component to the heat exchanger as known by applicant's omission of known/convention prior art.

Conclusion

Applicant is reminded that he has elected species A as illustrated in Figure 1. A shift in species is not permissible in an RCE.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Atkinson whose telephone number is (703) 308-2603.


C.A.

August 12, 2002

CHRISTOPHER ATKINSON
PRIMARY EXAMINER